

**REMARKS**

Claims 1 and 3-14 are pending and under consideration in this application. Claims 1, 5, 6, 7, and 9-14 are amended herein. Support for the amendments to claims 1, 5, 6, 7, and 9-14 may be found at page 12, lines 15-25 of the specification. Further reconsideration is requested based on the foregoing amendment and the following remarks.

**Form PTO-892**

The Applicants acknowledge with appreciation the PTO-892 citing U.S. Patent Application Publication 2001/0011232 to Peterson et al., (hereinafter "Peterson"), which was attached to the Advisory Action mailed May 24, 2006.

**U.S. Pat. App. Pub. 2002/0072974 to Pugliese, III et al.**

US Pat. App. Pub. 2002/0072974 to Pugliese, III et al. (hereinafter "Pugliese, III"), has a U.S. filing date of November 28, 2001. Although Pugliese, III purports to claim the benefit of U.S. Provisional Applications No. 60/194,016, filed Apr. 3, 2000 and U.S. Provisional Application No. 60/253,112, filed Nov. 27, 2000 under 35 U.S.C. § 119(e), Pugliese, III is ineligible for the benefit of the filing dates of either one, since Pugliese, III was filed *more than twelve months* after each of them. 35 U.S.C. § 119(e)(1), in particular, provides:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

Thus, the filing date of Pugliese, III is no earlier than November 28, 2001.

The subject application, on the other hand, claims priority to Japanese Patent Application No. 2001-340808, which was filed November 6, 2001. Pugliese, III is thus not a valid reference against the subject application, because the subject application pre-dates Pugliese, III. The rejections based on Pugliese, III are thus requested to be withdrawn.

**Response to Arguments:**

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action asserts at page 2, lines 11-15:

(I)n paragraph [0130], Pugliese includes a "Merchant Data Domain" in which is contained all merchant relative data required by the ShopLive system." Additionally, those data sets 'contain merchant catalog information and individual store inventory information (i.e. whether items are in or *out* of stock).

This is submitted to be incorrect, as discussed more fully below. Nowhere in paragraph [0130] does there appear any reference to managing information about items that are *out* of stock, contrary to the assertion in the final Office Action. In fact, it is submitted to be more probable that the "store specific inventory information," described in paragraph [0130] is simply a list of inventory carried by the store, without any idea of whether a product is available immediately or on back-order. This is in contrast to the claimed invention, in which "information regarding non-available products in each store," is managed.

The final Office Action asserts further at page 2, lines 15-18:

Furthermore, Pugliese states referring shoppers to other member merchants that carry the out of stock merchandise (see at least: [0042]). Pugliese thereby facilitates "managing information regarding non-available products in each store."

This is submitted to be incorrect, as discussed more fully below. It is the *first* member merchant who is known to be out of stock in paragraph [0042], not the *other* member merchant to whom the customer is being referred. There is no reason to believe that the first member merchant in Pugliese, III had any idea the item was out of stock until the customer inquired about it. In fact, there is no reason to believe, based on Pugliese, III, that the customer will have a better chance of finding the goods, services, and/or intellectual assets in stock at the *other* member merchant. There is simply no disclosure anywhere in Pugliese, III of "managing information regarding non-available products in each store," contrary to the assertion in the final Office Action.

The final Office Action asserts further at page 3, lines 2 and 3:

Pugliese clearly shows referring a shopper to another member merchant that has a non-available product available for sale.

This is submitted to be incorrect, as discussed more fully below. There is no reason to believe, based on Pugliese, III, that another member merchant to whom the customer is referred is any more likely than the first merchant to have the non-available product for sale. Pugliese, III, simply does not keep that information.

Rather, in Pugliese, III, the customer will have to inquire as to the availability of the goods all over again, at the second merchant. All the customer knows, based on Pugliese, III, is that the second merchant, like the first merchant, carries the goods. Whether the goods are actually in stock is another story. In particular, as described in paragraph [0010]:

The shopper asks questions or describes their interest and the merchant responds and offers suggestions and alternatives, display items via video camera or like device, refers the shopper to other merchants if they do not have the requested product, service, or intellectual assets, and provides information while describing features of the item as in an in-store shopping and sales encounter.

Referring the shopper to other merchants if they do not have the requested product, service, or intellectual assets does not amount to “when a purchaser selects a non-available product from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available,” contrary to the assertion in the final Office Action, since there is no reason to believe, based on Pugliese, III, that the referring merchant has any idea whether the requested product is actually available at the second merchant at all.

Still, in the interest of compact prosecution only, and not for any reason of patentability, the claims have been amended further to define non-available products as products that are not in inventory. Even if, arguendo, the merchant catalog information and individual store inventory information of Pugliese, III were read to include information as to whether items are in or out of *stock*, as the final Office Action asserts, that still necessarily excludes information about products that are not in inventory *at all*.

Further reconsideration is thus requested.

#### **Claim Rejections - 35 U.S.C. § 102:**

Claims 9, 10, 12, 13, and 14 were rejected under 35 U.S.C. § 102(e) as anticipated by Pugliese, III. Pugliese, III is not a valid reference against the subject application, because the subject application pre-dates Pugliese, III, as discussed above. In any case, the rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The second clause of claim 9 recites:

Managing information regarding products that are not in inventory for a plurality of stores.

Pugliese, III neither teaches, discloses, nor suggests “managing information regarding products that are not in inventory for a plurality of stores,” as recited in claim 9. In Pugliese, III, rather, the

*shopper* is left to discover whether a product is available (or not) for himself, by looking for it, not by “managing information regarding products that are not in inventory for a plurality of stores,” as recited in claim 9. In particular, as described in the Abstract,

If a shopper does not find the desired merchandise they are referred to another merchant who has the product and the referring merchants receives a commission or other consideration.

Since the *shopper* discovers that the merchandise is lacking in Pugliese, III, not the merchant, Pugliese, III does no “managing information regarding products that are not in inventory for a plurality of stores,” as recited in claim 9.

In Pugliese, III, in particular, the *shopper* is left to discover whether a related or out of stock product, service, or intellectual asset is not available from that merchant, not by “managing information regarding products that are not in inventory for a plurality of stores,” as recited in claim 9. In particular, as described in paragraph [0017],

Someone shopping on a given merchant's site in need of a related or out of stock product, service, or intellectual asset not available from that merchant, is referred to another member merchant that can satisfy the shopper's needs. For example, a shopper purchasing a light fixture, from a ShopLive merchant may need an electrician to install the light.

Since the *shopper* is left to discover that a related or out of stock product, service, or intellectual asset not available from that merchant in Pugliese, III, not the merchant, Pugliese, III does no “managing information regarding products that are not in inventory for a plurality of stores,” as recited in claim 9.

The third clause of claim 9 recites:

Introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog of a first store.

Pugliese, III neither teaches, discloses, nor suggests “introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog of a first store,” as recited in claim 9. In Pugliese, III, rather, walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property, rather than “introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog of a first store,” as recited in claim 9. In particular, as described in paragraph [0242],

Walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property.

Since walk-in shoppers to a fixed site are restricted to those merchants and product selection available within the specific property in Pugliese, III, Pugliese, III does not "introducing a purchaser to a second store in which a product selected by a purchaser is available when the purchaser selects a product that is not in inventory from a catalog of a first store," as recited in claim 9.

Claim 10:

The second clause of claim 10 recites:

Managing information regarding products that are not in inventory for a plurality of stores.

Pugliese, III neither teaches, discloses, nor suggests "managing information regarding products that are not in inventory for a plurality of stores," as discussed above with respect to the rejection of claim 9.

The third clause of claim 10 recites:

Shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a product that is not in inventory from a catalog of a first store.

Pugliese, III neither teaches, discloses, nor suggests "shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a product that is not in inventory from a catalog of a first store," as discussed above with respect to the rejection of claim 9. Claim 10 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 9. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claim 12:

The second clause of claim 12 recites:

Managing information regarding products that are not in inventory in each store, a product that is not in inventory being a product that is out of stock.

Pugliese, III neither teaches, discloses, nor suggests "managing information regarding products that are not in inventory in each store, a product that is not in inventory being a product that is out of stock," as discussed above with respect to the rejection of claim 9.

The third clause of claim 12 recites:

Performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available when the purchaser selects the product that is not in inventory from the catalog of one store.

Pugliese, III neither teaches, discloses, nor suggests “performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available when the purchaser selects the product that is not in inventory from the catalog of one store,” as discussed above with respect to the rejection of claim 9. Claim 12 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 12. Withdrawal of the rejection of claim 12 is earnestly solicited.

Claim 13:

The second clause of claim 13 recites:

Managing information regarding products that are not in inventory in each store, the product that is not in inventory being a product that is out of stock.

Pugliese, III neither teaches, discloses, nor suggests “managing information regarding products that are not in inventory in each store, the product that is not in inventory being a product that is out of stock,” as discussed above with respect to the rejection of claim 9.

The third clause of claim 13 recites:

Performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available when the purchaser selects a product that is not in inventory from the catalog of one store.

Pugliese, III neither teaches, discloses, nor suggests “performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available when the purchaser selects a product that is not in inventory from the catalog of one store,” as discussed above with respect to the rejection of claim 9. Claim 13 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 13. Withdrawal of the rejection of claim 13 is earnestly solicited.

Claim 14:

The second clause of claim 14 recites:

Managing information regarding products that are not in inventory for a plurality of stores.

Pugliese, III neither teaches, discloses, nor suggests “managing information regarding products that are not in inventory for a plurality of stores,” as discussed above with respect to the rejection of claim 9.

The third clause of claim 14 recites:

Shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a product that is not in inventory from a catalog of a first store.

Pugliese, III neither teaches, discloses, nor suggests “shipping a product selected by a purchaser from a second store in which the product selected by the purchaser is available when a purchaser selects a product that is not in inventory from a catalog of a first store,” as discussed above with respect to the rejection of claim 9. Claim 14 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 14. Withdrawal of the rejection of claim 14 is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 103:**

Claims 1, 3-6, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pugliese, III in view of US Patent No. 5,761,649 to Hill et al. (hereinafter “Hill”). Pugliese, III is not a valid reference against the subject application, because the subject application pre-dates Pugliese, III, as discussed above. In any case, the rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The second clause of claim 1 recites:

Managing information regarding products that are not in inventory in each store, a product that is not in inventory being a product that is out of stock.

Pugliese, III neither teaches, discloses, nor suggests “managing information regarding products that are not in inventory in each store, a product that is not in inventory being a product that is out of stock,” as discussed above with respect to the rejection of claim 9. Hill does not either, and thus cannot make up for the deficiencies of Pugliese, III with respect to claim 1.

The third clause of claim 1 recites:

When a purchaser selects the product that is not in inventory from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available.

Pugliese, III neither teaches, discloses, nor suggests “when a purchaser selects the product that is not in inventory from the product catalog of one store, introducing the purchaser to another

store in which the product selected by the purchaser is available,” as discussed above with respect to the rejection of claim 9. Hill does not either, and thus cannot make up for the deficiencies of Pugliese, III with respect to claim 1.

The fourth clause of claim 1 recites:

Updating the information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger.

Pugliese, III neither teaches, discloses, nor suggests “updating the information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger,” as recited in claim 1. The final Office Action seeks to compensate for this deficiency of Pugliese, III with respect to claim 1 by combining Pugliese, III with Hill, saying at page 6, lines 3-8:

The invention lacks, however, the aspect of automation as well as updating catalog/inventory information based on those operator instructions. Hill discloses a system that automatically updates catalog information based on an operator instruction. It should be noted that the term “purchaser trigger” is equivalent to “operator instruction.”

This is submitted to be incorrect. The operator, i.e. the vendor, or, more precisely, the vendor's computer is updating the catalog information in Hill, not the customer. The purchaser, i.e. the customer in Hill has no say about the matter.

Furthermore, the catalog information on the *customer's* computer is being updated in Hill, not “information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger,” as recited in claim 1. In particular, as described in Hill at column 2, lines 9-16:

Once the desired catalog data has been selected, the electronic catalog system automatically calls the vendor's computer and logs on. The catalog system first checks to determine whether any of the constant data on the customer's computer requires updating. If a constant data update is required, this update is completed prior to filling the customer's request for information.

Since, in Hill, the vendor's computer is updating the catalog information customer's computer, Hill is not “updating the information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger,” as recited in claim 1.

Furthermore, the catalog information in Hill is not inventory information at all, let alone “information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger,” as recited in claim 1. Hill, rather, is concerned with the difficulties of providing text and graphics to customers over dial-up connections. There is no



information about the *content* of the text and graphics at all, beyond the categorical description "catalog information." In particular, as described at column 1, lines 24-29:

The primary disadvantage of a dial-up system is that graphics data cannot be transmitted from the vendor's computer to the customer's computer in a meaningful time frame. It takes a large amount of time to transmit graphics data over telephone lines via a modem, especially if high resolution is desired. Therefore, the dial-up system is not practical for catalogs which include both graphics data and textual data.

Since Hill is concerned with sending graphics to customers, Hill is not "updating the information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger," as recited in claim 1.

The final Office Action asserts further at page 6, lines 11-13 that:

It is reasonable to point out that the selection of a catalog constitutes and operator instruction, this a purchaser trigger, and results in automated updating process of catalog information.

This is submitted to be incorrect. Even if it were reasonable, the catalog being updated resides on the customer's computer, as discussed above, and is thus not "information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger," as recited in claim 1. According to this interpretation of Hill in the final Office Action, rather, the flow of information occurs in the wrong direction, from the *vendor* to the *customer*. There is no reason to suspect that the customer's activities are prompting any revision of data at the vendor in Hill at all. Thus, even if an operator instruction, which is not mentioned in Hill in the first place, were considered to trigger an update of a customer's computer, that still does not amount to "updating the information regarding products that are not in inventory in each store using selection of a product catalog by a purchaser as a trigger," as recited in claim 1. Thus, even if Pugliese, III and Hill were combined, as proposed in the final Office Action, the claimed invention would not result.

The final Office Action asserts further at page 6, lines 13-18 that:

It would have been obvious to someone of ordinary skill in the art to design the system of Pugliese et al. with such a feature as in Hill because the accuracy of the data sent to the customer would no longer depend the distribution of updated disks (Hill, col. 1, lines 32-39) thus, making it easier for customers to obtain accurate information and suppliers to maintain it.

Here, again, according to the interpretation of Hill in the final Office Action, the flow of information occurs in the wrong direction, from the vendor to the customer. Thus, even if Pugliese and Hill were combined, as proposed in the final Office Action, the claimed invention

would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-6 depend from claim 1 and add further distinguishing elements. Claims 3-6 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-6 is also earnestly solicited.

Claim 11:

The second clause of claim 11 recites:

Managing information regarding products that are not in inventory in each store, the products being out of stock.

Neither Pugliese nor Hill show “managing information regarding products that are not in inventory in each store, the products being out of stock,” as discussed above with respect to the rejection of claim 1. Thus, even if Pugliese and Hill were combined, as proposed in the final Office Action, the claimed invention would not result.

The third clause of claim 11 recites:

When a purchaser selects a product that is not in inventory from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available.

Neither Pugliese nor Hill show “when a purchaser selects a product that is not in inventory from the product catalog of one store, introducing the purchaser to another store in which the product selected by the purchaser is available,” as discussed above with respect to the rejection of claim 1. Thus, even if Pugliese and Hill were combined, as proposed in the final Office Action, the claimed invention would not result.

The fourth clause of claim 11 recites:

Updating the information regarding products that are not in inventory in each store using selection of a product from the product catalog by a purchaser as a trigger.

Neither Pugliese nor Hill show “updating the information regarding products that are not in inventory in each store using selection of a product from the product catalog by a purchaser as a trigger,” as discussed above with respect to the rejection of claim 1. Thus, even if Pugliese, III and Hill were combined, as proposed in the final Office Action, the claimed invention would not result. Claim 11 is thus believed to be allowable for at least those reasons discussed above with

respect to the rejection of claim 1. Withdrawal of the rejection of claim 11 is also earnestly solicited.

Claims 7 and 8:

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pugliese, III in view of Peterson. Pugliese, III is not a valid reference against the subject application, because the subject application pre-dates Pugliese, III, as discussed above. In any case, the rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The second clause of 7 recites:

Managing information regarding products that are not in inventory in each store, a product that is not in inventory being a product that is out of stock.

Pugliese, III neither teaches, discloses, nor suggests “managing information regarding products that are not in inventory in each store, the product that is not in inventory being a product that is out of stock,” as discussed above with respect to the rejection of claim 9. Peterson does not either, and thus cannot make up for the deficiencies of Pugliese, III with respect to claim 7.

The third clause of claim 7 recites:

Performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store.

Pugliese, III neither teaches, discloses, nor suggests “performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store,” as recited in claim 7. Peterson does not either, and thus cannot make up for the deficiencies of Pugliese, III with respect to claim 7.

Peterson, rather, is about equalizing inventory among vendors, rather than “performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store,” as recited in claim 7. In particular, as described in paragraph [0004]:

This invention relates to a process for integrating a maintenance supply network with an information network for selectively distributing information about inventory levels and pricing among vendors, and efficiently transferring inventory between

parties according to prearranged terms.

Since Peterson is about equalizing inventory among vendors, Peterson is not "performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store," as recited in claim 7. Thus, even if Pugliese, III and Peterson were combined, as proposed in the final Office Action, the claimed invention would not result.

Furthermore, Peterson is about transferring items rapidly from a first vendor to a second vendor upon request by the second *vendor*, rather than "when the purchaser selects the product that is not in inventory from the product catalog of one store," as recited in claim 7. In particular, as described in paragraph [0033]:

This will help assure a rapid transfer of the item from the first vendor to the second vendor upon request by the second vendor, since virtually all the issues tending to hinder a rapid sale are dealt with ahead of time in the agreement.

Since Peterson is about transferring items rapidly from a first vendor to a second vendor upon request by the second vendor, Peterson is not "performing a shipment process of ordering the product selected by a purchaser from another store in which the product is available to a store in which the product is not in inventory when the purchaser selects the product that is not in inventory from the product catalog of one store," as recited in claim 7. Thus, even if Pugliese, III and Peterson were combined, as proposed in the final Office Action, the claimed invention would not result. Claim 7 is thus submitted to be allowable. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 8 depends from claim 7 and adds additional distinguishing elements. Claim 8 is thus also submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1 and 3-14 are allowable over the cited references.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 10/083,488

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 27 JUN 06

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